

REMARKS

The Final Office Action dated January 21, 2010, notes that claims 44-50 are withdrawn and listed the following: claims 1 and 42 are objected to due to informalities; claims 1-3, 5-7, 9-10, 14-16, 23-39 and 41-43 stand rejected under 35 U.S.C. § 102(e) over McLaren *et al.* (U.S. Patent No 6,064,794); claims 4, 11-12, 17-19 and 21-22 stand rejected under 35 U.S.C. § 103(a) over the '794 reference in view of Gupta *et al.* (U.S. Patent No. 7,313,808); claims 8, 13 and 20 stand rejected under 35 U.S.C. § 103(a) over the '794 reference in view of Birmingham *et al.* (U.S. Patent No. 6,868,224); and claim 40 stands rejected under 35 U.S.C. § 103(a) over the '794 reference in view of Lane (U.S. Patent No. 6,141,486). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant believes that the objection to claim 1 has been overcome for the reasons presented in Applicant's prior response, which is fully incorporated herein by reference. As explained therein, the objection is premised upon a lack of understanding of Applicant's specification and claims as discussed in more detail hereafter in regards to the rejection under 35 U.S.C. § 102(e).

Applicant submits that the objection to claim 42 is contrary to the notice of February 23, 2010 by the Director of the U.S. Patent and Trademark Office, David Kappos (1351 OG 212) (emphasis added): "A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim. Cf. *Animals - Patentability*, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987) (suggesting that applicants add the limitation "non-human" to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals per se." The basis for this conclusion rests, in part, upon the reasonable conclusion regarding the requisite knowledge of the skilled artisan (*e.g.*, the skilled

artisan understands that computer instructions could/would be stored on a non-transitory storage medium). Applicant has amended the claim to include the precise words “non-transitory” in an effort to facilitate prosecution. Applicant requests that the objection be removed so as to comply with the current USPTO practice.

Applicant respectfully traverses each of the rejections for failing to correspond to each claim limitation. Applicant notes that the explanation provided in the Advisory Action of March 17, 2010 does not address the failings of the rejection. The Advisory Action appears to misinterpret Applicant’s previous arguments. Applicant’s previous response explained that a trick play speed is achieved by playing trick play clips at a speed slower than the trick play speed, while alternating playing fast skim clips at a speed faster than the trick play speed. Thus, a single average/overall trick play speed is achieved by playing clips at two different speeds. The Examiner’s citation to different play streams is not relevant to such claim limitations as they simply represent different trick play speeds and do not teach achieving a trick play speed by playing two different clip types at two different rates. This aspect has yet to be addressed in the rejections, and Applicant encourages a brief review of Applicant’s specification, which discusses such aspects in great detail.

Notwithstanding, Applicant has made minor amendments to the claims in an effort to facilitate prosecution. The amendments include an express statement that a clip includes multiple frames. Applicant submits that this aspect is consistent with the plain meaning of term clip and thus the amendment is not limiting (nor necessary), but instead simply facilitates prosecution.

With specific regards to the rejections under 35 U.S.C. § 103(a), none of the cited secondary references cure the deficiencies of the primary ‘794 reference. As such, the rejections are *prima facie* invalid. Moreover, the alleged combinations are not understood as the ‘794 reference is directed toward selecting between different streams and therefore does not contain both trick play clips and skim play clips arranged and/or used as claimed (*e.g.*, with selected and stored start indicators). Accordingly, modifications that are alleged to correspond to aspects thereof do not make sense. As such each of the rejections under 35 U.S.C. § 103(a) is improper and Applicant requests that they be withdrawn.

Applicant has also introduced new claims 51-55 and submits that these claims should be allowable, for the aforementioned reasons, and are fully supported by Applicant's specification (*see, e.g.*, FIG. 5; paragraphs 40-46, 50-53, published version).

In view of the remarks above, Applicant believes that each of the rejections/objections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, David Schaeffer, of NXP Corporation at (212) 876-6170.

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